

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application in view of the amendments and the remarks to follow. Claims 1-45 are pending in this application.

The amendments to the specification address minor informalities noted during review and/or bring the specification and drawings into mutual conformance. No new matter is added by the amendments to the specification.

35 U.S.C. § 102

The Office Action states (page 2, item 3) that "Claims 1- rejected [sic] under 35 U.S.C. §102(e) as being anticipated by Allard et al., US Patent Number 6,018,619, hereinafter Allard." Applicant infers from the body of the rejection that what had been intended was to state that claims 1-23 and 25-45 stand rejected as being anticipated. Applicant further infers that a different portion of 35 U.S.C. §102 was intended. Clarification of the rejection, and correction of the record, are respectfully requested. Put another way, no basis whatsoever for any anticipation rejection for claim 24 appears in the Office Action, and rejection of claim 24 as being unpatentable over Allard is inappropriate, if Allard is admissible as prior art only under the timing provisions of 35 U.S.C. §102(e) (see MPEP §706.02(l) et seq. and 35 U.S.C. §103(c)).

Anticipation is a legal term of art. Applicant notes that in order to provide a valid finding of anticipation, several conditions must be met: (i) the reference must include every element of the claim within the four corners of the reference (see MPEP §2121); (ii) the elements must be set forth as they are recited in the claim (see MPEP §2131); (iii) the teachings of the reference cannot be modified (see MPEP §706.02, stating that "No question of obviousness is present" in conjunction with anticipation); and (iv) the reference must enable the invention as recited in the claim (see MPEP §2121.01). Additionally, (v) these conditions must be simultaneously satisfied.

The §102 rejection of claims 1-23 and 25-45 is believed to be in error. Specifically, the PTO and Federal Circuit provide that §102 anticipation requires that each and every element of the claimed invention be disclosed in a single prior

art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). The corollary of this rule is that the absence from a cited §102 reference of any claimed element negates the anticipation. *Kloster Speedsteel AB, et al. v. Crucible, Inc., et al.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

No §103 rejection has been lodged regarding claims 1-23 and 25-45. Accordingly, if Applicant can demonstrate that Allard does not disclose any one claimed element with respect to claims 1-23 and 25-45, the §102 rejections must be withdrawn, and a subsequent non-final action made with a different rejection in the event that the Examiner still finds such claims to be not allowable.

Applicant notes the requirements of MPEP §2131, which states that "TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM." This MPEP section further states that "'A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)."

Allard is directed to (Title) a "Method, system and apparatus for client-side usage tracking of information server systems". Allard describes: "A method for tracking usage patterns of users of hyper-media systems, such as the World-Wide

"Mixing and matching" disparate portions of a reference to attempt to find anticipation requires impermissible modification of the reference and also fails to demonstrate enablement, in the sense of 35 U.S.C. §112, 1ST ¶, as is required in order to support a valid finding of anticipation.

Independent claim 8 recites "A method comprising: receiving a request for a document; and returning, in response to the request, the document including a reference to content that causes information regarding the request for the document to be logged at a remote logging server", while independent claim 17 recites "A method, implemented in a logging server, comprising: receiving a request for content, the request having been submitted so that access to a web page on another server could be logged; logging information embedded in the request; and responding to the request with the content", which recitations are not taught or disclosed by Allard.

The Office Action states (page 4, item 11, with respect to claim 8; and, identically, with exception of claim numbers, at page 4, item 13, with respect to claim 17) that: "Referring to claims 8-15, claims 8-15 encompass the same scope of the invention as that of claims 1-7. Therefore, claims 8-15 are rejected for the same reason [sic] as the claims 1-7." Applicant disagrees, and notes that the recitation of independent claim 8 differs from that of claim 1. As noted above, the rejection of claim 1 and claims dependent therefrom is clearly defective. No mention whatsoever of any method as recited in claim 8 is noted in the Office Action, nor is any mention of any method, as recited in claim 17. Clarification, and demonstration of the subject matter recited these claims, in any such rejection, is respectfully requested.

Web, that creates a usage log on a user's client computer and periodically transmits the usage log from the user's client machine to a usage tracking server computer to be incorporated in an overall usage log for a given information server computer. Alternatively, proxy server may be connected between a client computer and an information server with the proxy server acting as a client to the information server and creating a usage log of the user's client computer access to the information server computer to be sent to usage tracking computer. Each time a user connects to a Web site, the client computer or proxy server creates a usage log that records all objects retrieved from that particular Web site and other attributes of user processing such as time spent viewing an object, amount of an object viewed, etc. Periodically, upon the occurrence of one of more predefined events that signify the end of a session, computer or proxy server saves the usage log into a single, compressed file and transmits the resulting file to the server. Events that signify the end of a session and trigger the transmission of a usage log from the user's client computer or proxy server computer to the usage tracking server computer may include a predetermined time interval, accessing a predetermined number of objects, application program or operating system shut down, connecting to a different Web site, and/or modem shut down." (Abstract).

In contrast, claim 1 recites: "A system comprising: a plurality of web servers, each storing a plurality of web pages and returning selected ones of the plurality of web pages to a plurality of requesting client devices; a central logging server coupled to the plurality of web servers; wherein each of the plurality of web pages for which centralized logging is desired includes a reference to content stored on the central logging server; and wherein the central logging server logs

accesses to the plurality of web servers upon receipt, from the requesting client devices, of a request for the content", which is not taught or disclosed by Allard.

The Office Action cites (pages 2 and 3) disparate portions of Allard in attempting to find anticipation of claim 1. More specifically, the Office Action cites (item 4(a), page 2) column 5, lines 36-44, taken from the Summary; column 9, lines 11 and 12, taken from the Detailed Description and specifically directed to Fig. 1, with reference to a portion of the recitation of the first clause following the preamble of claim 1. The Office Action then cites (item 4(b), page 2) the Abstract, stating that a: "proxy server is viewed as a central logging server". Such comprises impermissible modification of the teachings of the reference, see item (iii), supra, and referenced citations.

To clarify the nature of anticipation with respect to all of the anticipation rejections of Applicant's claims, Applicant notes the following language set forth in 35 U.S.C. §103(a):

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This language sets forth Congressional intent in clear and exact terms as to what does or does not comprise anticipation, as compared to unpatentability. The reference must contain, within its four corners, **exactly** the subject matter of the claim, as it appears in the claim, in order to support a valid finding of anticipation.

The Office Action then further cites (item 4(c), page 3) a portion of the Background, with respect to yet another portion of the recitation of claim 1.

Independent claim 26 recites "A method comprising: sending a request to access a web page at a first server; receiving the web page including an indication of additional content to be obtained from a second server so that access to the web page can be logged at the second server; and sending another request to the second server for the additional content", which is not taught or disclosed by Allard. The Office Action states (page 4, item 15) that such "claims encompass the same scope of the invention as claims 1-7" etc. Independent claim 26, having not been rejected under 35 U.S.C. §112, 4TH ¶, stands on the record as having been acknowledged by the Office as comprising subject matter of noticeably different scope than the preceding independent claims.

Independent claim 30 recites "A method of tracking web usage, the method comprising: adding, to each of a plurality of web pages, a reference to content stored at a central logging server; and logging, at the central logging server, information embedded in the reference, wherein the central logging server is accessed by a remote device to obtain the content when any of the plurality of web pages is rendered", which is not taught or disclosed by Allard. The Office Action states (page 5, item 17) substantially the same argument as noted hereinabove. Again, the subject matter of claim 30 has not been rejected as noted above, and the Office Action further fails to state meaningful grounds of rejection for claim 1.

Independent claim 35 recites "A method comprising: including, in a web page to be stored at a web server, a reference to content stored on a logging server, the reference having embedded therein an indication to the logging server that the web server was accessed", which is not taught or disclosed by Allard.

Independent claim 39 recites "A computer readable medium having stored thereon a web page, the web page including portions that, when interpreted by a plurality of instructions being executed by one or more processors, causes the plurality of instructions to perform acts including: indicating to a centralized logging server that a web server hosting the web page has been accessed", which is not taught or disclosed by Allard. The Office Action references claim 39 et seq. as noted above (in item 21, on page 5), parroting the language quoted hereinabove.

In summary, Allard fails to provide the elements of Applicant's claims, and thus cannot possibly provide them as they are set forth in the claims. As a result, it is impossible for Allard to enable the subject matter of Applicant's claims in the sense of 35 U.S.C. 112, and requires modification impermissible in a valid finding of anticipation to achieve the subject matter of Applicant's claims. Inasmuch as Allard fails each of the four prongs of the tests set forth in the MPEP for determination of anticipation, Allard cannot possibly satisfy those prongs simultaneously. Accordingly, the anticipation rejection of claims 1-23 and 25-45 fails all five of the above-noted criteria for anticipation. The rejection of claims 1-23 and 25-45 is in error and should be withdrawn, and claims 1-23 and 25-45 should be allowed.

35 U.S.C. § 103

Claim 24 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Allard. Applicant respectfully disagrees and requests reconsideration.

The Office Action states (page 6, item 23) that "Allard does not explicitly tell the response is less than 50 bytes. However, it is the designer's choice to choose the number of bytes for the response. Allard has taught that the server return acknowledgement back to the client upon client request (Col. 5 lines 36-39). It would have been obvious" As noted above, Allard fails to provide the elements for which it is cited.

Claim 24 recites "A method as recited in claim 17, wherein the responding comprises returning a response of less than 50 bytes to a device the request was received from", which is not taught, disclosed, suggested or motivated by the cited reference.

Applicant notes that such is an explicit acknowledgement that Allard fails to meet the requirements set forth in the MPEP for establishing a prima facie finding of obviousness. More specifically, MPEP simply providing a conclusory statement that "It would have been obvious" fails to meet the standards set forth in the MPEP for establishing a prima facie case of unpatentability. These are set forth in MPEP §2143, entitled "Basic Requirements of a Prima Facie Case of Obviousness" (see also MPEP §706.02(j), §2141 et seq. and §2142).

This MPEP section states that "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine reference teachings." The reference fails to teach or disclose the elements recited in the claims, as discussed with specificity, *infra*. Accordingly, the reference cannot provide motivation to modify the teachings of the reference to arrive at the invention as claimed, and the Examiner has identified no such teaching or disclosure in the reference. As a result, the first prong of the test cannot be met.

MPEP §2143 further states that "Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Inasmuch as the reference fails to provide all of the features recited in Applicant's claims, the third prong of the test is not met. As a result, there cannot be a reasonable expectation of success. As such, the second prong of the test cannot be met.

MPEP §2143 additionally states that "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." This fourth criterion cannot be met because the reference fails to teach or disclose the elements recited in the claim. As such, the unpatentability rejection fails all of the criteria for establishing a prima facie case of obviousness, as set forth in the MPEP.

There is no teaching or disclosure, or guidance, suggestion or motivation identified in the reference or by the Office Action to attempt to combine or modify, or to aid one of ordinary skill in picking and choosing elements from the diverse embodiments of the reference or in assembling those elements to attempt

to arrive at the subject matter of any of Applicant's claims. As such, the rejection appears to employ an inappropriate 'obvious to try' standard of unpatentability.

Such is improper, as is discussed below in more detail with reference to MPEP §2145(X)(B), entitled "Obvious To Try Rationale". This MPEP section states that "The admonition that 'obvious to try' is not the standard under §103 has been directed mainly at two kinds of error. In some cases, what would have been 'obvious to try' would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. In others, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it." *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (citations omitted)".

In this instance, no guidance in selecting some but not others of the many elements from the various aspects of the reference is identified. Similarly, no direction as to which of many possible choices is likely to be successful has been identified.

As there is no basis for the Examiner's contentions within the cited reference, the only possible motivation for these contentions is hindsight reconstruction wherein the Examiner is utilizing Applicant's own disclosure to construct a reason for combining and/or modifying the teachings of the cited references. The Examiner is reminded that hindsight reconstruction is not an

appropriate basis for a §103 rejection. (See, e.g., *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990) (explaining that hindsight reconstruction is an improper basis for rejection of a claim).)

Moreover, no evidence has been provided as to why it would be obvious to combine or modify the teachings of this reference. Evidence of a suggestion to combine or modify may flow from the prior art references themselves, from the knowledge of one skilled in the art, or from the nature of the problem to be solved. However, this range of sources does not diminish the requirement for actual evidence. Further, the showing must be clear and particular. See *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999).


For at least these reasons, the rejection of claim 24 is defective and should be withdrawn, and claim 24 should be allowed.

Conclusion

Claims 1-45 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

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By: 
Frederick M. Fliegel
Reg. No. 36,138
(509) 324-9256 x239